

Attorney Docket No.: UT-0033  
Inventors: Mujtaba et al.  
Serial No.: 10/009,455  
Filing Date: April 19, 2002  
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#### REMARKS

Claim 5 is pending in the instant application. Claim 5 has been rejected. Claim 5 has been amended. New dependent claim 9 has been added. Support for these amendments is provided in the specification at page 12 and page 18-19. Thus, no new matter is added by this amendment. Reconsideration is respectfully requested in light of the amendment and the following remarks.

#### **I. Rejection of Claim 5 under 35 U.S.C. 112, first paragraph**

Claim 5 has been rejected under 35 U.S.C. 112, first paragraph. The Examiner has acknowledged the specification to enabling for stem cells capable of contributing to all cell lineages from an ES-D3 cell line grown under specifically controlled conditions. However, the Examiner suggests that the specification does not enable any person skilled in the art to practice and carry out the invention commensurate in scope with the claim.

Accordingly, in an earnest effort to advance the prosecution of this case, but without conceding in any way to the Examiner's rejection, Applicants have amended claim 5 to specify the ES-D3 cell line. Further Applicants have added new dependent claim 9 which sets forth the differentiation-inducing conditions. Support for these

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amendments is provided at page 12 and pages 18-19 of the specification.

Withdrawal of this rejection under 35 U.S.C. 112, first paragraph is therefore respectfully requested.

**II. Rejection of Claim 5 under 35 U.S.C. 112, second paragraph**

Claim 5 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests that the metes and bounds of the phrase "from a cell line which contributes to all cell lineages" can not be determined.

It is respectfully pointed out that this phrase has been deleted from the pending claims, thus mooting this rejection.

Withdrawal of this rejection is therefore respectfully requested.

**III. Rejection of Claim 5 under 35 U.S.C. 103**

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (March 1998, reference BF) in view of Rao et al. (U.S. Patent No. 6,361,996). The Examiner suggests that it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to isolate glial restricted precursor cells as

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disclosed by Rao et al. (1998) from a mouse because Rao et al. ('996) also disclose the mouse to be a source of precursors as well, for carrying out the steps of incubating and isolating via immunoselection.

Applicants respectfully traverse this rejection.

Arguments presented previously by Applicants that the starting material of embryonic stem cells is different were found unpersuasive because the Examiner suggests that the features upon which the Applicants rely are not recited in the rejected claims.

Applicants respectfully disagree as the phrase "mouse embryonic stem cells" is included in step (a) of claim 5.

In addition, in an earnest effort to further clarify the different starting material of this method, Applicants have amended claim 5 to state mouse embryonic stem cells from an ES-D3 cell line. Applicants have also added new dependent claim 9 which states that the ES-D3 cell line are induced to differentiate into glial-restricted precursor cells by plating the cells on poly L-lysine/laminin coated dishes. Support for these amendments is provided at pages 12 and 18-19 of the instant specification.

MPEP 2116.01 is clear; all the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. Proper claim

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construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. MPEP 2116.01.

Both Rao et al. and U.S. Patent 6,361,996 are silent with respect to use of mouse embryonic stem cells from an ES-D3 cell line as a starting material in a process for isolating a pure population of mouse glial-restricted precursor cells. Further, these references provide no teaching or suggestion relating to conditions for inducing mouse embryonic stem cells of the ES-D3 cell line to differentiate into glial-restricted precursor cells. Accordingly, these references clearly fail to provide the requisite teaching or suggestion of all claim limitations to render the instant claimed invention obvious as well as the motivation to make or use the claimed starting material.

Withdrawal of this rejection under 35 U.S.C. 103(a) is therefore respectfully requested.

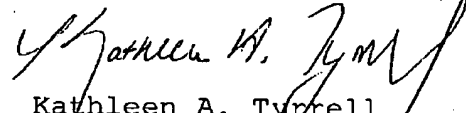
#### IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

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Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

  
Kathleen A. Tyrrell  
Registration No. 38,350

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LICATA & TYRRELL P.C.  
66 E. Main Street  
Marlton, New Jersey 08053  
(856) 810-1515